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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,174	03/27/2002	Prahalad Manibhai Mistry		9731

9629 7590 09/15/2003

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/15/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/089,174

Applicant(s)

MISTRY, PRAHALAD MANIBHAI

Examiner

Helene Klemanski

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,9-11 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 3,5,6,8 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Specification***

1. The disclosure is objected to because of the following informalities: on page 2, line 19 of the specification, the term "R1" should be replaced with the term "R<sup>1</sup>".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "selected from" is considered indefinite since this is improper Markush language. It is the examiner's position that other materials could be present in the Markush group that were not intended by applicants by the use of the phrase "selected from" since this phrase does not exclude other materials. The examiner suggests the language "selected from the group consisting of" in place of this phrase.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

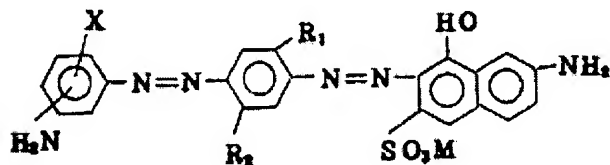
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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 9-11 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0611811.

EP 0611811 teaches a recording liquid used for inkjet printing comprising an aqueous medium and 0.5-5% by weight of a dye of the formula



wherein  $R_1$  and  $R_2$  each represent  $\text{CH}_3$  or  $\text{OCH}_3$ ,  $X$  represents  $\text{SO}_3\text{M}$  and  $M$  represents an alkali metal, an ammonium or an organic amine. The ink may contain more than one of the dyes of the above formula and may also contain other azo dyes of the formulas as disclosed. See page 3, lines 40-43, page 4, lines 10-51, dye of the formula (II), page 5, lines 7-14, page 6, dye compound (II-2), page 13, dye compound (F), page 13, lines 55-57, page 14, lines 1-25, example 7 and claims 1, 3, 11 and 13. The recording liquid as taught by EP 0611811 appears to anticipate the present claims.

The only limitation in the claims not found by the examiner is the ppm of the total divalent and trivalent metal ions in the ink composition is below 500. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain an ink composition with applicants claimed amount of divalent and trivalent metal ions since they are the same composition.

***Allowable Subject Matter***

6. Claims 3, 5, 6, 8 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: None of the cited prior art teaches or fairly suggests an azo compound of the formula as claimed by applicants wherein: (1)  $n$  is 1; (2) at least one of  $R^1$  and  $R^2$  carries an OH group and (3)  $R^3$  and  $R^4$  are each independently  $C_{1-4}$  alkyl,  $C_{1-4}$ -alkyl-OH, phenyl or phenyl substituted with a carboxy and/or sulpho group, or  $R^3$  and  $R^4$  together with the nitrogen atom to which they are attached form an optionally substituted morpholino or piperidino ring.

***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is 703-308-3745. The examiner can normally be reached on Monday-Friday 5:30-2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
September 8, 2003